

Notice of Allowability

Application No.

09/937,100

Examiner

T. D. Wessendorf

Applicant(s)

CARR, FRANCIS J

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/27/2007.
2. ☒ The allowed claim(s) is/are 71,72 and 91.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

T.D. WESSENDORF
PRIMARY EXAMINER

Art Unit 1639
10/10/07

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Atty. Traverso and Atty. Kiesey on September 28, 2007 and on 10/4/07 with Atty. Kiesey.

The application has been amended as follows:

CLAIMS:

Claim 91, lines 1-2, "an antigen-binding portion thereof" has been deleted, and ----antibody domain----has been inserted.

Claim 91, lines 2-3, after interest, "said antibody being a member of a library of antibodies " has been deleted, and ---- comprising----: (i) providing an antibody library ----- has been inserted.

Claim 91, line 6, "comprising" has been deleted.

Claim 91, line 7, "i" has been changed to --- (ii) ---; **line 9**, "(ii)" to --- (iii) --- and after complex of "(i)" to --- (ii) -; **line 10**, "(iii)" to --- (iv) ---; **line 12**, "(iv)" to --- (v) --- and

Art Unit: 1639

line 14, "(v)" to ---(vi)--- and "(i)" to ---(ii)---, "(iv)" to ---(v)---.

Claim 91, line 17, "genease, thrombin" has been deleted.

Claim 91, line 19, "antigen-binding" has been deleted.

Claim 71, line 1, "74" has been changed to ---91---.

Claim 72, line 1, "74" has been changed to ---91---.

Claims 74-78 and 80-90 have been cancelled.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: the prior art does not teach or suggest the claimed method of identifying an antibody that binds to an antigen of interest. The antibody is identified or obtained from a library with the members of the library having unique sequence tract flanked by protease sensitive sites.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 1639

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it fails to recite the foreign priority claim made or recited in the ADS. There is inconsistency between the foreign priority claim in the oath and ADS. Also, some of the certified copies are not on file (i.e., 9907642.6, 990665.8 and 9916511.0.) It is therefore unclear as to which priority applicants intend to claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571) 272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/937,100

Page 5

Art Unit: 1639

T.D. 7
T. D. Wessendorf
Primary Examiner
Art Unit 1639

Tdw

October 10, 2007